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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/748,359

12/26/2000

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051078-0020US

4094

28977 7590 03/14/2012
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EXAMINER

PORTER, RACHEL L

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

03/14/2012

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/748,359	Applicant(s) LENCKI ET AL.	
	Examiner RACHEL L. PORTER	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-4, 6-12, 14-21, 25-31, 33-40, 42-48, 50-51, 70-73, 75-79, 81-82, and 106, 108-110 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Continuation of Disposition of Claims: Claims pending in the application are 1-4,6-12,14-21,25-31,33-40,42-48,50,51,70-73,75-79,81,82,106 and 108-110.

DETAILED ACTION

1. This communication is in response to the amendment filed 8/26/11. Claims 1-4, 6-12, 14-21, 25-31, 33-40, 42-48, 50-51, 70-73, 75-79, 81-82, 106, and 108-110 are pending. Claims 108-110 have been newly added. (It is noted that applicant's remarks state that claims 108-110 have been cancelled.)
2. A previous request for continued examination under 37 CFR 1.114 was filed in this application on 2/17/11, after a decision by the Board of Patent Appeals and Interferences, rendered 9/1/10.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/26/11 has been entered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wizig (USPN 6,735,569) in view of Warady et al. (US 6067522)

[claim 108] Wizig teaches a method of establishing a health care benefits offering to an employee group comprising:

- establishing a healthcare cost for said group; (Figures 4A-D, 32, col. 16, lines 19-47, e.g. family plans) and
- establishing a plurality of health care line different items based on said cost. (Figures 31-32, col. 16, lines 19-47)
- receiving an insurance coverage package selection from an employee in the group wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figures 25, 37-38; 55; col. 14, lines 38-64)
- for each of the plurality of benefit categories automatically included in the package, receiving via the user interface a purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

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Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses:

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Claim 108 further recites, "at least one of the different line items displayed on the interface includes a predefined contribution to said employee for purchase of at least one of said line items (claim 22), said predefined contribution being provided by an employer of said employee." (The limitations of claim 23.)

Wizig discloses a method wherein at least one of the different line items displayed on the interface includes a predefined employer contribution to said employee for purchase of said at least one of said line items. (col. 12, lines 24-29; Figure 30, 53), wherein said employee's employer provides said predefined contribution. (col. 12, lines 24-29; Figure 24)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, are nonfunctional description material and are not functionally involved in the steps recited. In particular, the steps recited in claim 40 would be performed the same regardless of the data contents of the noted material (i.e. the data displayed on the screen, simultaneously or otherwise). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See

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In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

6. Claims 1-4, 6-12, 15-17, 20-21, 24-31, 34-36, 39-40, 42-48, 51, 70-73, 75-79, 82 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wizig (USPN 6,735,569) in view of Warady et al. (US 6067522), and in further view of Valentino (US 4,648,037)

[claim 1] Wizig discloses a method of providing benefits to an employee comprising:

- receiving an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)
- for each of the plurality of benefit categories automatically included in the package receiving via the user interface an initial purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

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- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses

simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to

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provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, are nonfunctional description material and are not functionally involved in the steps recited. In particular, the steps recited in claim 1 would be performed the same regardless of the data contents of the noted material (i.e. the data displayed on the screen, simultaneously or otherwise). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claim 1 has been amended to recite: “analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection...” and

“providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.”

Wizig and Warady in combination do not expressly disclose “analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial

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purchase selection” and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.

Valentino discloses a system and method comprising “analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection” col. 6, lines 49-col. 7, lines 41; col. 7, lines 59-col. 8, line 55; col. 14, lines 2-50; --selection of benefits, calculation of what -if scenarios and additional suggestions; col. 8, line 66- col. 9, line 54) and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage. (col. 8, line 66- col. 9, line 54; col. 9, lines 40-55—enrolling user in initial and additional coverage)

At the time of the applicant’s invention, it would have been obvious to one of ordinary skill in the art to modify the system and method Wizig and Warady in combination with the teachings of Valentino. As suggested by Valentino, one would have been motivated to include these features to allow the employee to bring together the best combination of benefits to achieve the individually desired level of coverage, while at the same time maximizing savings and minimizing costs and taxes. (col. 14, lines 57-65)

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[claim 2] Wizig teaches a method wherein at least one of the different line items displayed on the interface includes a predefined employer contribution to said employee for purchase of said at least one of said line items. (col. 12, lines 24-29; Figure 30, 53)

[claims 3-4] Wizig teaches a method wherein said plurality of benefit categories comprises insurance (e.g. health insurance) benefits. (col. 12, lines 24-29, Figure 33)

[claims 6-7] Wizig teaches a method wherein said benefit costs to the employee for purchasing the coverage under the benefit category are established based on prior cost data or actuarial data. (col. 9, lines 50-67; col. 16, lines 47-col. 17, line 23; col. 20, lines 54-col. 21, line 50)

[claim 8] Wizig teaches a method further comprising: identifying a plurality of options for purchase by said employee within said line items. (Fig. 33)

[claim 9] Wizig teaches a method wherein said options comprise cost sharing options. (col. 8, lines 59-col. 9, line 19; Figure 33: sponsoring and co-payment)

[claim 10] Wizig teaches a method wherein said options comprise place of service options. (Figure 28: e.g. distance in miles/time from providers)

[claim 11] Wizig teaches a method wherein said options comprise benefit provider network options. (col. 13, lines 30-51; col. 15, lines 43-57)

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[claim 12] Wizig teaches a method according to claim 8, said method further comprising: identifying a plurality of sub-options for purchase by said employee within said options. (Figures 30-31,55; col. 14, lines 38-64)

[claim 15] Wizig teaches a method wherein said computer network is a global computer network and wherein said user interface is provided at a web site on said network. (col. 6, lines 1-24)

[claim 16] Wizig teaches a method further comprising: identifying factors on said user interface for said employee to consider in connection with the purchase of one or more of said line items. (Figures 26-29)

[claim 17] Wizig teaches a method according to claim 1, said method further comprising:

- querying said employee through said user interface for personal information related to said employee (Figure 20; Figure 28 e.g. preferences); and
- explaining the need for said personal information on said user interface. (Figure 28—explains how preference information is used)

[claim 20] Wizig teaches a method further comprising:

- creating data comprising personal information related to said employee and representing each said line item purchased by said employee; and (col. 10, lines 66-col. 11, line 8, lines 14-31; Figures 4A-4D, col. 13, lines 18-col. 14, line 25)

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- transmitting said data to a customer service vendor configured to automatically build a customer benefit summary for said employee based on said data. (Figure 33, 55; col. 14, lines 38-64—e.g. Express Buy)

[claim 21] Wizig discloses a method of providing healthcare to an employee comprising:

- receiving an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)
- for each of the plurality of benefit categories automatically included in the package, receiving via the user interface a purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost

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parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can

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easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, are nonfunctional description material and are not functionally involved in the steps recited. In particular, the steps recited in claim 21 would be performed the same regardless of the data contents of the noted material (i.e. the data displayed on the screen, simultaneously or otherwise). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claim 21 has been further amended to recite, "at least one of the different line items displayed on the interface includes a predefined contribution to said employee for purchase of at least one of said line items (claim 22), said predefined contribution being provided by an employer of said employee." (The limitations of claim 23.)

Wizig discloses a method wherein at least one of the different line items displayed on the interface includes a predefined employer contribution to said employee for purchase of said at least one of said line items. (col. 12, lines 24-29; Figure 30, 53), wherein said employee's employer provides said predefined contribution. (col. 12, lines 24-29; Figure 24)

[claims 25-26] Wizig teaches a method wherein said wherein said benefit costs to the employee for purchasing the coverage under the benefit category are established based

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on prior cost data or actuarial data. (col. 9, lines 50-67; col. 16, lines 47-col. 17, line 23; col. 20, lines 54-col. 21, line 50)

[claim 27] Wizig teaches a method further comprising: identifying a plurality of options for purchase by said employee within said line items. (Fig. 33)

[claim 28] Wizig teaches a method wherein said options comprise cost sharing options. (col. 8, lines 59-col. 9, line 19; Figure 33: sponsoring and co-payment)

[claim 29] Wizig teaches a method according to claim 27, wherein said options comprise place of service options. (Figure 28: e.g. distance in miles/time from providers)

[claim 30] Wizig teaches a method wherein options comprise benefit provider network options. (col. 13, lines 30-51; col. 15, lines 43-57)

[claim 31] Wizig teaches a method further comprising: identifying a plurality of sub-options for purchase by said employee within said options. (Figures 30-31,55; col. 14, lines 38-64)

[claim 34] Wizig teaches method wherein said computer network is a global computer network and wherein said user interface is provided at a web site on said network. (col. 6, lines 1-24)

[claim 35] Wizig teaches a method further comprising: identifying factors on said user interface for said employee to consider in connection with the purchase of one or more of said line items. (Figures 26-29)

[claim 36] Wizig teaches a method further comprising: querying said employee through said user interface for personal information related to said employee Figure 20;

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Figure 28 e.g. preferences); and explaining the need for said personal information on said user interface. (Figure 28—explains how preference information is used)

[claim 39] Wizig teaches a method further comprising:

- storing data comprising personal information related to said employee and representing each said line item purchased by said employee; and (col. 10, lines 66-col. 11, line 8, lines 14-31; Figures 4A-4D, col. 13, lines 18-col. 14, line 25)
- transmitting said data to a customer service vendor configured to automatically build a customer benefit summary for said employee based on said data. (Figure 33, 55; col. 14, lines 38-64—e.g. Express Buy)

[claim 40] Wizig teaches a method of establishing a health care benefits offering to an employee group comprising:

- establishing a healthcare cost for said group; (Figures 4A-D, 32, col. 16, lines 19-47, e.g. family plans) and
- establishing a plurality of health care line different items based on said cost. (Figures 31-32, col. 16, lines 19-47)
- said method further comprising:
- receiving an insurance coverage package selection from an employee in the group wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated

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with the benefit type (e.g. insurance—benefit type); (Figures 25, 37-38; 55; col. 14, lines 38-64)

- for each of the plurality of benefit categories automatically included in the package, receiving via the user interface an initial purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses:

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user

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interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, are nonfunctional description material and are not functionally involved in the steps recited. In particular, the steps recited in claim 40 would be performed the same regardless of the data contents of the noted material (i.e. the data displayed on the screen, simultaneously or otherwise). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See

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In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claim 40 has been amended to recite: “analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection...” and providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.

Wizig and Warady in combination do not expressly disclose “analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection” and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.

Valentino discloses a system and method comprising “analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection” col. 6, lines 49-col. 7, lines 41; col. 7, lines 59-col. 8, line 55; col. 14, lines 2-50; --selection of benefits, calculation of what -if scenarios and additional suggestions; col. 8, line 66- col. 9, line 54) and “providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.”

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(col. 8, line 66- col. 9, line 54; col. 9, lines 40-55—enrolling user in initial and additional coverage)

At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system and method Wizig and Warady in combination with the teachings of Valentino. As suggested by Valentino, one would have been motivated to include these features to allow the employee to bring together the best combination of benefits to achieve the individually desired level of coverage, while at the same time maximizing savings and minimizing costs and taxes. (col. 14, lines 57-65)

[claims 42-43] Wizig teaches a method wherein healthcare costs are established based on prior cost data or actuarial data. (col. 9, lines 50-67; col. 16, lines 47-col. 17, line 23; col. 20, lines 54-col. 21, line 50)

[claim 44] Wizig teaches a method further comprising: establishing a plurality of options within at least one of said line items. (Fig. 33)

[claim 45] Wizig teaches a method wherein said options comprise cost sharing options. (col. 8, lines 59-col. 9, line 19; Figure 33: sponsoring and co-payment)

[claim 46] Wizig teaches a method wherein said options comprise place of service options. (Figure 28: e.g. distance in miles/time from providers)

[claim 47] Wizig teaches a method wherein said options comprise benefit provider network options. (col. 13, lines 30-51; col. 15, lines 43-57)

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[claim 48] Wzig teaches method further comprising: establishing a plurality of sub-options within at least one of said options. (Figures 30-31,55; col. 14, lines 38-64)

[claim 51] Wzig teaches a method wherein said computer network is a global computer network and wherein said user interface is provided at a web site on said network. (col. 6, lines 1-24)

[claim 70] Wzig teaches a system for providing benefits to an employee comprising:

- at least one database; (col. 7, line 47-56; Figures 1- 2)
- at least one processor for accessing said database; (Figs. 1-2; col. 6, line 62-col. 7, line 46) and
- a user-interface accessible through a computer network (col. 6, lines 15-24) for accessing said processor (Figures 1-2; 30-31; col. 6, lines 4-34)
- wherein the at least one processor receives an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)
- wherein for each of the plurality of benefit categories automatically included in the package, the at least one processor receives via the user interface a purchase selection from the employee corresponding to one of the plurality of different line

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items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)

- wherein the at least one processor is used for providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses:

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage

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provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Claim 70 has been further amended to recite, "at least one of the different line items displayed on the interface includes a predefined contribution to said employee for purchase of at least one of said line items (claim 22), said predefined contribution being provided by an employer of said employee." (The limitations of claim 23.)

Wizig discloses a method wherein at least one of the different line items displayed on the interface includes a predefined employer contribution to said employee for purchase of said at least one of said line items. (col. 12, lines 24-29; Figure 30, 53), wherein said employee's employer provides said predefined contribution. (col. 12, lines 24-29; Figure 24)

[claim 71] Wzig teaches a system wherein said at least one database further comprises data representing a predefined employer contribution to said employee for purchase of at least one of said line items. (Figure 2, 15--col. 12, lines 16-28—sponsor contribution amount is stored (i.e. sponsor individual database))

[claims 72-73] Wzig teaches a system wherein at least one said benefit categories comprises insurance and wherein the insurance benefits comprise health insurance benefits. (col. 12, lines 24-29, Figure 33)

[claim 75] Wzig teaches a system wherein said database further comprises data representing a plurality of options for purchase by said employee within said line items. (Fig. 33)

[claim 76] Wzig teaches a system wherein said options comprise cost sharing options. (col. 8, lines 59-col. 9, line 19; Figure 33: sponsoring and co-payment)

[claim 77] Wzig teaches a system wherein said options comprise place of service options. (Figure 28: e.g. distance in miles/time from providers)

[claim 78] Wzig teaches a system wherein said options comprise benefit provider network options. (col. 13, lines 30-51; col. 15, lines 43-57)

[claim 79] Wzig teaches a system wherein said at least one database further comprises data representing a plurality of sub-options for purchase by said employee within said options. (Fig. 13)

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[claim 82] Wizig teaches a system wherein said computer network is a global computer network and wherein said user interface is provided at a web site on said network. (col. 6, lines 1-24)

[claim 109] Wizig teaches a system for providing benefits to an employee comprising:

- at least one database; (col. 7, line 47-56; Figures 1- 2)
- at least one processor for accessing said database; (Figs. 1-2; col. 6, line 62-col. 7, line 46) and
- a user-interface accessible through a computer network (col. 6, lines 15-24) for accessing said processor (Figures 1-2; 30-31; col. 6, lines 4-34)
- wherein the at least one processor receives an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)
- wherein for each of the plurality of benefit categories automatically included in the package, the at least one processor receives via the user interface an initial purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- wherein the at least one processor is used for providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit

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categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses:

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only,

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employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Claim 109 further recites: "analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection..." and "providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage."

Wizig and Warady in combination do not expressly disclose "analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection" and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.

Valentino discloses a system and method comprising “analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection” col. 6, lines 49-col. 7, lines 41; col. 7, lines 59-col. 8, line 55; col. 14, lines 2-50; --selection of benefits, calculation of what -if scenarios and additional suggestions; col. 8, line 66- col. 9, line 54) and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage. (col. 8, line 66- col. 9, line 54; col. 9, lines 40-55—enrolling user in initial and additional coverage)

At the time of the applicant’s invention, it would have been obvious to one of ordinary skill in the art to modify the system and method Wizig and Warady in combination with the teachings of Valentino. As suggested by Valentino, one would have been motivated to include these features to allow the employee to bring together the best combination of benefits to achieve the individually desired level of coverage, while at the same time maximizing savings and minimizing costs and taxes. (col. 14, lines 57-65)

7. Claims 14,18-19,33,37-38,50,81, and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wizig (USPN 6,735,569), Warady (US 6067522) and Valentino, and in further view of Spurgeon (USPN 5,890,129)

[claim 14] Wizig teaches a method and system for providing benefits to an individual (e.g. employee), and for providing a user interface for the selection of benefits over a

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computer network (col. 6, lines 15-24, Figures 1-2), but does not expressly disclose that the computer network is a local area network. Spurgeon discloses the use of local area networks (LAN's) to provide/transmit insurance benefits data (Figure 1; col. 6, lines 61-col. 7, line 7). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Wizig to include LAN's among the types of networks used to transmit/provide benefits data. As suggested by Spurgeon, one would have been motivated to include this feature to allow different parties (e.g. insurers/ healthcare providers) to continue to use their existing systems, while reaping the benefits of automatic exchange of insurance benefits information. (col. 2, lines 64-67)

[claims 18] Wizig teaches a method further comprising storing data representing each said line item purchased by said employee (Figures 9 and 15; col. 9, lines 6-19; col. 10, lines 16-31—databases store information on items purchased by employee). Wizig also teaches a method wherein profiles are created for the user, but does not expressly disclose transmitting the stored data to a benefit claims processing vendor configured to automatically build a benefit profile for said employee based on said data. Spurgeon teaches a method wherein data gathered/stored from the user on selected benefits is transmitted to a benefit claims processing vendor (i.e. insurer or third party reviewer), which may build a profile of the individual (i.e. store a profile of the insured in a database). (Spurgeon: col. 4, lines 7-18; col. 6, lines 16-43). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to

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modify the system/method of Wizig with the teaching of Spurgeon to provide user information to a benefit claims processor vendor (i.e. insurer/third party reviewer), which may provide a profile of the user. As suggested by Spurgeon, one would have been motivated to include this feature to increase the speed with which claims may be processed and paid (col. 4, lines 43-46) and to provide a mechanism for updating providers on the status of a patient/subscriber (i.e. the employee purchasing benefits). (col. 8, line 54-57)

[claim 19] Wizig and Spurgeon teach the method of providing benefits of claim 18 as explained in the rejection of 18. However, Wizig does not disclose claims processing and as such, does not disclose that the recited claims processing vendor is configured to confirm eligibility for payment of benefit claims based on the user's benefit profile. Spurgeon teaches a method and system wherein the benefit claims processing vendor (i.e. insurer or third party reviewer) is configured to confirm eligibility for payment of benefit claims based on the user's benefit profile. (col. 4, lines 7-18; col. 10, line 45-col. 11, line 10). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Wizig with the teaching of Spurgeon to have the claims processing vendor confirm status (i.e. eligibility) of the subscriber based upon the stored user information. As suggested by Spurgeon, one would have been motivated to include this feature to increase the speed with which claims may be processed and paid (col. 4, lines 43-46).

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[claim 33] Wizig teaches a method and system for providing benefits to an individual (e.g. employee), and for providing a user interface for the selection of benefits over a computer network (col. 6, lines 15-24, Figures 1-2), but does not expressly disclose that the computer network is a local area network. Spurgeon discloses the use of local area networks (LAN's) to provide/transmit insurance benefits data (Figure 1; col. 6, lines 61-col. 7, line 7). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Wizig to include LAN's among the types of networks used to transmit/provide benefits data. As suggested by Spurgeon, one would have been motivated to include this feature to allow different parties (e.g. insurers/ healthcare providers) to continue to use their existing systems, while reaping the benefits of automatic exchange of insurance benefits information. (col. 2, lines 64-67)

[claim 37] The limitations of claim 37 are addressed by the rejections of claims 18 and 21, and incorporated herein.

[claim 38] The limitations of claim 38 are addressed by the rejections of claims 19 and 37, and incorporated herein.

[claim 50] Wizig teaches a method and system for providing benefits to an individual (e.g. employee), and for providing a user interface for the selection of benefits over a computer network (col. 6, lines 15-24, Figures 1-2), but does not expressly disclose that the computer network is a local area network. Spurgeon discloses the use of local area

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networks (LAN's) to provide/transmit insurance benefits data (Figure 1; col. 6, lines 61-col. 7, line 7). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Wzig to include LAN's among the types of networks used to transmit/provide benefits data. As suggested by Spurgeon, one would have been motivated to include this feature to allow different parties (e.g. insurers/ healthcare providers) to continue to use their existing systems, while reaping the benefits of automatic exchange of insurance benefits information. (col. 2, lines 64-67)

[claim 81] Wzig teaches a method and system for providing benefits to an individual (e.g. employee), and for providing a user interface for the selection of benefits over a computer network (col. 6, lines 15-24, Figures 1-2), but does not expressly disclose that the computer network is a local area network. Spurgeon discloses the use of local area networks (LAN's) to provide/transmit insurance benefits data (Figure 1; col. 6, lines 61-col. 7, line 7). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Wzig to include LAN's among the types of networks used to transmit/provide benefits data. As suggested by Spurgeon, one would have been motivated to include this feature to allow different parties (e.g. insurers/ healthcare providers) to continue to use their existing systems, while reaping the benefits of automatic exchange of insurance benefits information. (col. 2, lines 64-67)

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[claim 106] Wizig teaches a method of providing benefits to an employee comprising:

- receiving an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)
- identifying a predefined employer contribution to said employee on said user interface for purchase of at least one of said line items. (col. 12, lines 24-29; Figure 24)
- for each of the plurality of benefit categories automatically included in the package receiving via the user interface an initial purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)
- storing data representing each said line item purchased by said individual (Figures 9 and 15; col. 9, lines 6-19; col. 10, lines 16-31—databases store information on items purchased by employee)
- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each

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of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been

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motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Furthermore, it should be noted that these limitations regarding the data that are displayed on the screen, are nonfunctional description material and are not functionally involved in the steps recited. In particular, the steps recited in claim 1 would be performed the same regardless of the data contents of the noted material (i.e. the data displayed on the screen, simultaneously or otherwise). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claim 106 has been amended to recite: “analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection...” and providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.

Wizig and Warady in combination do not expressly disclose “analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection” and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage.

Valentino discloses a system and method comprising “analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection” col. 6, lines 49-col. 7, lines 41; col. 7, lines 59-col. 8, line 55; col. 14, lines 2-50; --selection of benefits, calculation of what -if scenarios and additional suggestions; col. 8, line 66- col. 9, line 54) and providing the insurance coverage package in accordance with the initial purchase selections made by the employee and any additional purchase selections made based on the offer for additional coverage. (col. 8, line 66- col. 9, line 54; col. 9, lines 40-55—enrolling user in initial and additional coverage)

At the time of the applicant’s invention, it would have been obvious to one of ordinary skill in the art to modify the system and method Wizig and Warady in combination with the teachings of Valentino. As suggested by Valentino, one would have been motivated to include these features to allow the employee to bring together the best combination of benefits to achieve the individually desired level of coverage, while at the same time maximizing savings and minimizing costs and taxes. (col. 14, lines 57-65)

Wizig also teaches a method wherein profiles are created for the user, but does not expressly disclose transmitting the stored data to a benefit claims processing vendor configured to automatically build a benefit profile for said employee based on said data.

Spurgeon teaches a method wherein data gathered/stored from the user on selected benefits is transmitted to a benefit claims processing vendor (i.e. insurer or third party reviewer), which may build a profile of the individual (i.e. store a profile of the insured in

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a database). (Spurgeon: col. 4, lines 7-18; col. 6, lines 16-43). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Wizig, Warady and Valentino with the teaching of Spurgeon to provide user information to a benefit claims processor vendor (i.e. insurer/third party reviewer), which may provide a profile of the user. As suggested by Spurgeon, one would have been motivated to include this feature to increase the speed with which claims may be processed and paid (col. 4, lines 43-46) and to provide a mechanism for updating providers on the status of a patient/subscriber (i.e. the employee purchasing benefits). (col. 8, line 54-57).

8. Claim 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wizig (USPN 6,735,569), and Warady (US 6067522) and in view of Spurgeon (USPN 5,890,129).

[claim 110] Wizig teaches a method of providing benefits to an employee comprising:

- receiving an insurance coverage package selection from the employee wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type (e.g. insurance—benefit type); (Figure 55; col. 14, lines 38-64)
- identifying a predefined employer contribution to said employee on said user interface for purchase of at least one of said line items. (col. 12, lines 24-29; Figure 24)
- for each of the plurality of benefit categories automatically included in the package receiving via the user interface a purchase selection from the employee

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corresponding to one of the plurality of different line items associated with the benefit category; and (Fig. 30, 33; col. 14, lines 38-64; Figure 55)

- storing data representing each said line item purchased by said individual (Figures 9 and 15; col. 9, lines 6-19; col. 10, lines 16-31—databases store information on items purchased by employee)
- providing the insurance coverage package corresponding to the benefit type and including the plurality of benefit categories to the employee in accordance with the purchase selections made by the employee (Col. 16, lines 47-col. 17, line 39)

Wizig discloses a method for customizing insurance coverage, as explained, but does not expressly disclose:

- simultaneously displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero.

Warady discloses

- simultaneously displaying a plurality of different line items associated with the benefit category (e.g. medical: Description of options A-M) to the employee on a

user interface accessible through a computer network wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category (out of pocket cost— e.g. deductible) and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category (cost for employee only, employee+children; employee+spouse; employee+spouse) and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero (Fig. 7A-B).

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Wizig with the teaching of Warady to provide users with information on out-of-pocket costs as they are selecting a personalized healthcare plan. As suggested by Warady, one would have been motivated to include this feature to ensure that the employee is informed of and can easily enroll in the various plan options that match their needs. (col. 9, lines 49-col. 10, line 8)

Claim 110 further recites, "at least one of the different line items displayed on the interface includes a predefined contribution to said employee for purchase of at least one of said line items (claim 22, previously appealed), said predefined contribution being provided by an employer of said employee." (The limitations of claim 23, previously appealed)

Wizig discloses a method wherein at least one of the different line items displayed on the interface includes a predefined employer contribution to said employee for purchase of said at least one of said line items. (col. 12, lines 24-29; Figure 30, 53), wherein said employee's employer provides said predefined contribution. (col. 12, lines 24-29; Figure 24)

Also it should be noted that these limitations regarding the data that are displayed on the screen, are nonfunctional description material and are not functionally involved in the steps recited. In particular, the steps recited in claim 1 would be performed the same regardless of the data contents of the noted material (i.e. the data displayed on the screen, simultaneously or otherwise). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Wizig also teaches a method wherein profiles are created for the user, but does not expressly disclose transmitting the stored data to a benefit claims processing vendor configured to automatically build a benefit profile for said employee based on said data.

Spurgeon teaches a method wherein data gathered/stored from the user on selected benefits is transmitted to a benefit claims processing vendor (i.e. insurer or third party reviewer), which may build a profile of the individual (i.e. store a profile of the insured in a database). (Spurgeon: col. 4, lines 7-18; col. 6, lines 16-43). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Wizig and Warady in combination with the teaching of

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Spurgeon to provide user information to a benefit claims processor vendor (i.e. insurer/third party reviewer), which may provide a profile of the user. As suggested by Spurgeon, one would have been motivated to include this feature to increase the speed with which claims may be processed and paid (col. 4, lines 43-46) and to provide a mechanism for updating providers on the status of a patient/subscriber (i.e. the employee purchasing benefits). (col. 8, line 54-57)

Response to Amendment

9. The declaration under 37 CFR 1.132 filed 2/17/11 is insufficient to overcome the rejection of claims 1-4, 6-12, 14-23, 25-31, 33-40, 42-48, 50-51, 70-73, 75-79, 81-82 and 106 based upon 35 USC 103 as set forth in the last Office action because: While the applicant has provided articles describing the use and sale of a consumer driven health benefits for customizing options, the declaration fails to establish that there was a long felt-need for the applicant's claimed invention.

It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

Response to Arguments

10. Applicant's arguments filed 8/26/11 have been fully considered but they are not persuasive.

(A) Applicant argues that the prior art does not disclose the limitation of: at least one of the different line items displayed on the interface includes a predefined contribution to said employee for purchase of at least one of said line items, said predefined contribution being provided by an employer of said employee."

In response, it is noted that this limitation/ these limitations are those from cancelled claim 23. Claim 23 was appealed, and the rejection was affirmed in a BPAI decision mailed 9/1/10.

Regarding applicants arguments that the prior art does not disclose these features, the matter has already been decided before BPAI. Board of Patent Appeals and Interferences decision in an application has ***res judicata*** effect and is the "law of the case" and is thus controlling in that application and any subsequent, related application. Therefore, a submission containing arguments without either an amendment of the rejected claims or the submission of a showing of facts will not be effective to remove such rejection.

(B) Applicant argues that the prior art does not teach the newly added feature(s) of "analyzing the initial purchase selection and displaying an offer for additional coverage based on the initial purchase selection."

These newly added limitations have been addressed with an additional reference/ new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Morgan can be reached on (571) 272-6773. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./
Examiner, Art Unit 3626

/Robert Morgan/
Supervisory Patent Examiner, Art Unit 3626